

BS01212

U.S. Application No. 10/002,667 Examiner PARDO, Art Unit 2175  
Request for Reconsideration in Response to Final Office Action

### **REMARKS**

In response to the final Office Action dated October 27, 2004, Assignee respectfully requests reconsideration based on the following remarks. Assignee respectfully submits that the pending claims are in condition for allowance.

The United States Patent and Trademark Office (the "Office") rejected claims 1-32 under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,208,986 to Schneck *et al.* in view of Published United States Patent Application 2002/0004794 to Mito *et al.* The Assignee shows, however, that the pending claims are patentably distinguishable over the proposed combination of Schneck and Mito, and the Assignee thus respectfully submits that the pending claims are ready for allowance.

### **Amendment to Independent Claim 1**

This response amends claim 1. Claim 1, however, is amended to include the same features already recited in independent claims 9 and 22. The Office thus has no cause to deny entry of this amendment.

### **Rejection of Claims under 35 U.S.C. § 103 (a)**

The Office rejected claims 1-32 under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,208,986 to Schneck *et al.* in view of Published United States Patent Application 2002/0004794 to Mito *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) the Examiner must identify "some suggestion or motivation...to modify the reference"; 2) the Examiner must identify "a reasonable expectation of success"; and 3) "the prior art reference must teach or suggest all the claim limitations." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). The Assignee shows, however, that the attempted combination of Schneck and Mito fails to teach or suggest all the features recited in the independent claims. The Assignee also shows that Examiner Pardo has failed to properly present a *prima facie* case for

BS01212

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obviousness. The Assignee thus respectfully requests that Examiner Pardo remove the § 103 (a) rejection and allow the pending claims.

**1. The *Prima Facie* Case of Obviousness Fails to Teach or Suggest All the Claimed Features**

Independent claims 1, 9, and 22 are not obvious. These claims all recite a database that is searched according to a search-order field. The search-order field determines an order in which the plurality of references is searched. The search-order field has an integer value and a reference having a lowest numerical value within the search-order field is first searched, and subsequent references are searched in an ascending order of the search-order field.

The Examiner's proposed combination of *Schneck* and *Mito* fails to teach or suggest such a search-order field. *Mito* describes a computer that searches scientific information. See Published United States Patent Application 2002/0004794 to Mito *et al.* at paragraph [0001], lines 5-7. Examiner Pardo is correct — when *Mito* searches the scientific information, the search results are arranged “hierarchized at at least three levels of field, category, and software product.” *Id.* at paragraph [0011], lines 10-12; paragraph [0012], lines 5-8; paragraph [0014], lines 5-7; and numerous other locations. *Mito*, however, arranges search results according to “scientific field,” and not according to ascending integer value. As *Mito* explains, the computer stores “scientific information which is information relating to scientific fields.” *Id.* at paragraph [0055], lines 4-5. “The field level in the hierarchy is divided into biology, chemistry, physics, medicine, and so on.” *Id.* at paragraph [0059], lines 3-5. *Mito*, then, sorts according to science discipline and not according to ascending integer values of the search-order field, as independent claims 1, 9, and 22 recite. The proposed combination of *Schneck* and *Mito* fails to teach or suggest the search-order field recited in claims 1, 9, and 22, so these independent claims must distinguish over the proposed combination. The Assignee thus respectfully requests that Examiner Pardo remove the § 103 rejection and allow the pending claims.

BS01212

U.S. Application No. 10/002,667 Examiner PARDO, Art Unit 2175  
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**2. The *Prima Facie* Case of Obviousness Must Fail for Lack of Teaching, Suggestion, or Motivation**

The Examiner's attempted *prima facie* case for obviousness fails to establish any teaching, suggestion, or motivation. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). **When the motivation to combine the teachings is not apparent, the Examiner has a duty to explain why the combination is proper. See *id.* at 2142; see also *In re Skinner*, 2 U.S.P.Q.2d (BNA) 1788 (Bd. Pat. App. & Inter. 1986) (emphasis added). Even if the references teach all aspects of the claimed invention, the Examiner's *prima facie* case must still include some objective reason to combine the references. See M.P.E.P. at § 2143.01; see also *In re Levengood*, 28 U.S.P.Q.2d (BNA) 1300 (Bd. Pat. App. & Inter. 1993) (emphasis added).**

Here, the office action fails to identify any teaching, suggestion, or motivation to combine the cited references. The Examiner makes no effort to explain why the proposed combination of *Schneck* and *Mito* is proper. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to either i) supplement the rejection in the next office action or ii) remove the rejection. If the Examiner chooses to supplement the rejection in the next office action, that next office action cannot be made final without violating the Assignee's Due Process rights.

**3. The *Prima Facie* Case of Obviousness Must Fail for Lack of Expectation of Success**

BS01212

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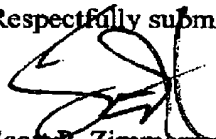
The Examiner's attempted *prima facie* case for obviousness fails to establish any expectation of success. If the Office wishes to establish a *prima facie* case of obviousness, the Examiner must identify a reasonable expectation of success. See DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P.").

Here, the office action fails to identify any expectation of success. The Examiner makes no effort to explain why one of ordinary skill in the art would expect success when attempting to combine *Schneck* and *Mito*. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,



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